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EXAMINER

FERGUSON, LAWRENCE D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/763,625
Filing Date: January 22, 2004
Appellant(s): ALMOG ET AL.

Julia Church Dierker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 15, 2010 appealing from the Office action mailed November 16, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 38, 40-43 and 45-47 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,565,301	BODAGER ET AL	10-1996
5,250,990	FUJIMURA ET AL	10-1993
4,602,058	GRAHAM ET AL	7-1986

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections – 35 USC § 102(b)

Claims 38, 40, 42-43, 45 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodager et al. (U.S. 5,565,301).

Bodager discloses a coated paper substrate comprising a carrier support (1), which is a paper substrate (column 4, lines 55-67 and Figure 3) along with a carrier surface layer (2) that is a cushion layer, which is preferably ethylene acrylic acid

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copolymer (column 5, lines 15-16, 49-62 and Figure 3). Bodager further discloses an anchor layer between the carrier cushion layer and carrier support layer that comprises polyamides (column 6, lines 10-24). The anchor layer is a Macromelt (column 20, lines 59-60) which Applicant defines as an amine terminated polyamide in paragraph 0005 in the instant specification. Bodager discloses colored images (print) are formed on the article (column 1, line 6, column 2, lines 39-40, column 5, lines 38-45). The anchor layer remains adhesively bonded to the layers on both sides (has a high affinity for the substrate and overlayer) (column 6, lines 10-15). In claims 38 and 43, the phrase, “toner image can be fused and fixed” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claims 38 and 43, the phrase, “for printing a toner image thereon” is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Because Bodager discloses a coated paper having the same layers, with the same materials it is inherent for the coated paper to be capable of being configured for printing a toner image thereon, as in claims 38 and 42-43 and 47.

Concerning claims 40 and 45, although the cushion layer can include additives as in column 5, line 66 through column 6, line 7, additives are not required in the layer; therefore it is reasonable to conclude that the layer is free of particulate matter.

Claim Rejections – 35 USC § 103(a)

Claims 38, 40-41, 43 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (U.S. 5,250,990) in view of Graham et al (U.S. 4,602,058).

Fujimura discloses a coated paper substrate comprising a paper substrate (column 8, lines 24-26) coated with a photosensitive layer, where the photosensitive layer comprises a charge generation layer and charge transportation layer (column 7, line 67 through column 8, line 1) where the charge generation layer and charge transportation layers comprise styrene butadiene copolymer (column 7, lines 14-26, 56-57). Fujimura further discloses a polyamide primer layer can be provided between the substrate layer and photosensitive layer (column 8, lines 27-34) which can be printed with a toner image (column 1, lines 13-23). In claim 38, the phrase, “toner image can be fused and fixed” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claim 38, the phrase, “for printing a toner image thereon” is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Fujimura does not disclose the polyamide layer is an amine terminated polyamide. Graham teaches a coated paper, where two layers are bonded together using an amine-terminated polyamide interlayer (column 11, lines 46-53, column 12, lines 60-68 and column 13, lines 1-4). Fujimura and Graham are combinable because they are related to a similar technical field, which is coated papers. It would have been obvious to one of ordinary skill in the art to substitute the amine terminated polyamide coating layer of Graham for the polyamide primer (coating) layer of Fujimura because Graham teaches polyamide layers are commercially made using amine-terminated polyamides (column 5, lines 33-38 and column 11, lines 46-53 of Graham), as in claim 38 and 41.

Concerning claims 40 and 45, the photosensitive layer appears to be free of particulate matter.

Concerning claims 43 and 46, the article is image forming and can be printed (column 1, lines 13-15). Because Fujimura and Graham disclose a printed article having a paper substrate coated with an underlayer and overlayer having similar materials, it is expected for the underlayer to have a high affinity for the substrate, for the overlayer to have a high affinity for toner and for the underlayer and overlayer to have high affinity for each other, absent any evidence to the contrary. In claim 43, the phrase, "toner image can be fused and fixed" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claim 43, the phrase, "for printing a toner image thereon" is an intended use. A recitation of the intended use of

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the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

(10) Response to Argument

Issue 1

Appellant argues the rejection of claims 38, 40, 42-43, 45 and 47 which were rejected under 35 U.S.C. 102(b) as being anticipated by Bodager et al. (U.S. 5,565,301). Appellant argues Bodager does not disclose or suggest a paper substrate, because the reference discloses a paper substrate that has been treated to be water resistant. Bodager discloses a coated paper substrate comprising a carrier support (1), which is a paper substrate (column 4, lines 55-67 and Figure 3). The reference does not disclose that the paper sheet has been treated to be water resistant, but that the synthetic paper has been treated to be water resistant. Therefore, Bodager meets the claim limitation of a paper substrate. Appellant argues Bodager should read i) a thin metal sheet that has been treated to be water resistant, ii) a paper substrate that has been treated to be water resistant, or iii) synthetic paper that has been treated to be water resistant. This recitation does not exist in the Bodager reference as column 4, lines 65-67 reads "The carrier support can also be a thin metal sheet or a paper

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substrate or synthetic paper that has been treated to be water resistant." Examiner maintains Bodager discloses a paper substrate based upon the actual disclosure of column 4, lines 65-67.

Issue 2

Appellant argues the rejection of Claims 38, 40-41, 43 and 45-46 which were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (U.S. 5,250,990) in view of Graham et al (U.S. 4,602,058). Appellant argues that an electroconductive substrate of Fujimura is not the same as a paper substrate, because the substrate includes paper impregnated with electroconductive particles (column 8, lines 24-26). Because Fujimura discloses a paper substrate, this disclosure meets the claim limitation of a paper substrate, as the instant claims do not exclude the paper substrate from being impregnated with additional materials. Appellant argues the Examiner is interpreting paper substrate too broadly. USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The broadest

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reasonable interpretation of paper substrate has been given in light of the supporting disclosure, as neither the claims nor the instant specification excludes additional materials in the paper substrate.

Appellant further argues, as admitted in the Office Action, Fujimura does not disclose an underlayer coating including amine terminated polyamide. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Graham teaches a coated paper, where two layers are bonded together using an amine-terminated polyamide interlayer (column 11, lines 46-53, column 12, lines 60-68 and column 13, lines 1-4). Appellant argues the underlayer coating as taught in Graham contains an amine terminated polyamide and ethylene copolymers containing carboxyl groups that forms a blend, where the instant claims contain an amine terminated polyamide and not a polyamide blend. Claims 38 and 43 disclose a coated paper substrate and a paper-based print media comprising an underlayer or undercoating that contains amine terminated polyamide. Because the articles comprise the substrates and coatings, the additional material of the polyamide layer is not excluded from the disclosure of the instantly claimed invention. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327F.3d 1364, 1368, 66 USPQ2d 1631, 1634

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(Fed. Cir. 2003). Appellant argues the Examiner is interpreting the underlayer coating to broadly as the specification states that the underlayer coating may be selected from the group consisting of amine terminated polyamide, a silane coupling agent, and amino propyl triethoxy silane, where the disclosure does not state that combinations, mixtures or blends may also be used in the coating. Examiner maintains that because the articles comprise the substrates and coatings, the additional material of the polyamide layer is not excluded from the disclosure of the instantly claimed invention, as neither the specification nor claims specifically state that additional materials are excluded from the polyamide layer. Appellant argues one skilled in the art would not turn to the teachings of Graham to supply the deficiencies of Fujimura. It would have been obvious to one of ordinary skill in the art to substitute the amine terminated polyamide coating layer of Graham for the polyamide primer (coating) layer of Fujimura because Graham teaches polyamide layers are commercially made using amine-terminated polyamides (column 5, lines 33-38 and column 11, lines 46-53 of Graham).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lawrence Ferguson/
Patent Examiner, Art Unit 1783

Conferees:

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1783

/Christine Tierney/
Supervisory Patent Examiner, Art Unit 1700